



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Stephen E. Reiter
Foley & Lardner
P.O. Box 80278
San Diego, CA 92138-0278

COPY MAILED

FEB 27 2006

In re Patent No. 6,835,544	: DECISION ON PATENT	OFFICE OF PETITIONS
Issued: December 28, 2004	: TERM ADJUSTMENT	
Application No. 09/742,684	: and NOTICE OF INTENT	
Filed: December 19, 2000	: TO ISSUE CERTIFICATE	
Dkt. No.: SALK1720-6	: OF CORRECTION	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705 (b)," filed October 12, 2004.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is **GRANTED TO THE EXTENT INDICATED HEREIN.**

Applicants request that the Determination of Patent Term Adjustment be corrected from the zero days indicated on the Determination of Patent Term Adjustment mailed July 12, 2004 to an adjustment of 613 days.

This application matured into U.S. Patent No. 6,835,544 on December 28, 2004. The patent issued with a PTA of 105 days. The instant application for patent term adjustment was timely filed under 37 CFR 1.705(b) on October 12, 2004.

A review of the history reveals that an adjustment of 15 days under 37 CFR 1.702(a)(1) and 1.703(a)(1) can be attributed to the Office.

The Office errantly entered November 15, 2002 as the date a response was submitted to the restriction requirement mailed March 6, 2002 when in fact, a response was timely submitted May 3, 2002, as established by the decision on petition mailed January 2, 2003 withdrawing the holding of abandonment. Thus, the reduction of 162 days is withdrawn.

As a result of the timely response to the restriction requirement filed May 3, 2002, an adjustment of 204 days under 37 CFR 1.702(a)(2) can be attributed to the Office. In accordance with 37 CFR 1.703(a)(2), the delay began September 4, 2002, the day after the date that is four months after the date

the reply was submitted, and ended March 26, 2003, the date of mailing of compliance notice.

Furthermore, the Office errantly entered January 12, 2004 as the date a proper response to the non-final Office action was submitted when in fact a proper response to the non-final Office action was timely submitted September 26, 2003, as indicated in the final rejection mailed March 19, 2004 which withdraw the holding of non-compliant amendment mailed December 12, 2003. Thus, the reduction of 108 days is withdrawn.

At the time of allowance, the adjustments under 37 CFR 1.702 totaled 219 days and there were no failures by applicants to engage in reasonable efforts to conclude prosecution.

Applicants further argue that at the time of allowance, the Office would have failed to issue the patent within three years.

Applicants are correct in that the Office did not issue the patent within 3 years of its filing date of December 19, 2000. Specifically, the patent issued on December 28, 2004, three years and 375 days after its filing date. Thus, the period of delay under 35 USC 154(b)(1)(B) and 37 CFR 1.702(b) is 375 days. See, 37 CFR 1.703(b).

However, if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See, 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See, also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004). In this instance, the periods of delay totaling 219 days attributable to grounds specified in § 1.702(a)(1) and § 1.702(a)(2) overlap with the 375 days attributable to the delay in the issuance of the patent. Thus, the period of adjustment cannot exceed the actual number of days of delay of 375 days.

In view thereof, at the time of issuance, the instant patent was entitled to a patent term adjustment of 375 days.

The required fee of \$200.00 for an application for patent term adjustment has been charged to Deposit Account 50-0872.

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 375 days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 6,835,544 B2
DATED : December 28, 2004
INVENTOR(S) : Mathews, et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 105 days

Delete the phrase "by 105 days" and insert – by 375 days--